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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Yellow Book USA, Inc.
v.
Interstate Publisher's Corp.

Cancellation No. 22,666

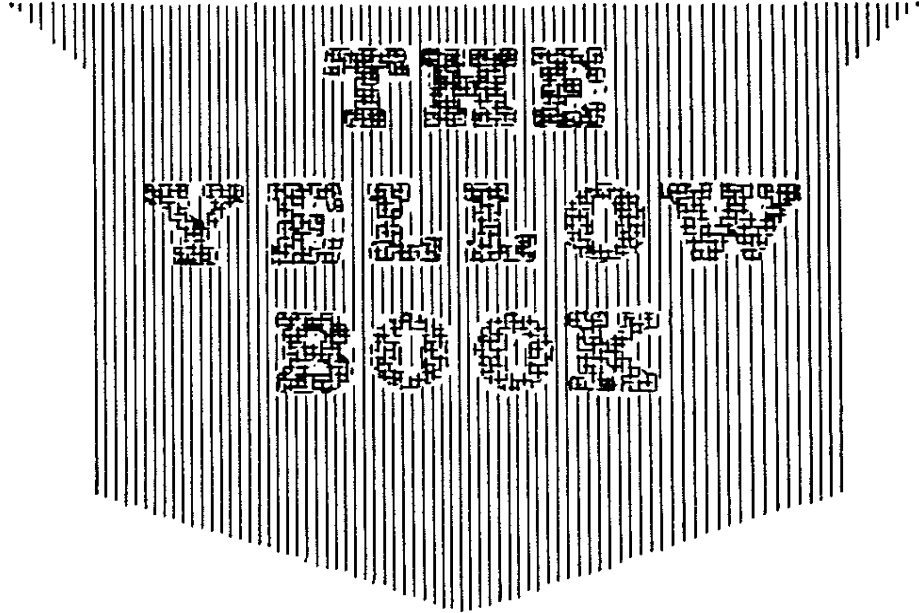
Alexandra Nicholson of Davis Wright Tremaine LLP for Yellow Book USA, Inc.

Charles E. Baxley of Hart, Baxley, Daniels & Holton for Interstate Publisher's Corp.

Before Seeherman, Walters, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 2, 1994, Petitioner, Yellow Book USA, Inc., through its predecessor, Multi-Local Media Corporation, filed a petition to cancel Registration No. 1,130,170 for the mark shown below on the Supplemental Register for "industrial directory, buyers guide and classified telephone directory published annually" in International Class 16.



The drawing is lined for the colors red and yellow. The registration is based on an application that was filed on April 7, 1978, and the registration issued on January 29, 1980.¹ The registration alleges a date of first use and a date of first use in commerce of January 1936.

Petitioner alleges that two of its applications (Serial Nos. 74/386,101 and 74/386,113) have been refused registration under Section 2(d) of the Trademark Act on the ground that petitioner's mark is confusingly similar to respondent's registration. 15 U.S.C. § 1052(d). The applications are both for the mark YELLOW BOOK, in typed form, and seek registration under the provision of Section

¹ Renewed.

2(f) of the Trademark Act. Serial number 74/386101 lists the goods as "community classified telephone and business classified telephone directories" in International Class 16 and No. 74/386,113 identifies the services as "telephone information services" in International Class 35.

The petition "does not seek to cancel registration of the Bel[l] Mark on 'Industrial Director[ies] Buyers Guide[s]'. It seeks to cancel such registration insofar as it encompasses 'Classified Telephone Director[ies] Published Annually.'" Petition to Cancel at 4 (first brackets not in original). Petitioner alleges that respondent has not used the mark on classified telephone directories and that petitioner has superior rights in the mark. Petitioner proposes to narrow respondent's identification of goods to "industrial directories/buyers guides published annually as classified telephone directories" or "manufacturing and industrial buyers guides, published annually as classified telephone directories." Petitioner's Brief at 22 and 23 n.24. Petitioner also proposes limiting the identification of goods in its pending application to "community-oriented 'yellow pages' classified telephone directories distributed free to all telephone subscribers located in the community served" or "classified 'yellow pages' directories, featuring information and advertising about the goods and services of

business and consumer entities organized by community or geographic groups or communities." Petitioner's Br. at 23.

Respondent admitted that petitioner "actually seeks rectification of the scope of goods covered in the Registration No. 1130170, rather than cancellation of the BELL Mark in toto," but otherwise denied the salient allegations of the petition to cancel. Answer at 3.²

The Record

The record consists of the file of the involved registration; the trial testimony deposition, with accompanying exhibits, of Joseph Walsh, petitioner's president; the trial testimony deposition, with accompanying exhibits, of John Beaver, petitioner's senior vice president of sales; the trial testimony deposition, with accompanying exhibits, of Ralph Kass, respondent's secretary-treasurer; petitioner's Notices of Reliance; and respondent's Notices of Reliance.

Both parties have filed briefs, and an oral hearing was held on March 4, 2003.

Background

Both petitioner and respondent are publishers of directories that contain information used by various consumers. Petitioner is a "yellow pages publisher."

² In its Amended Petition for Cancellation (p. 8), petitioner requests in the alternative, "[i]f the board finds that the registration is not overly broad, it must be cancelled."

Walsh dep. at 15. Yellow pages directories "contain classified advertising and a free comprehensive list of businesses for that small community or that metropolitan area, usually broken down into listings, column ads, display ads and national trademarks printed on what we consider light stock. In fact, it's even called directory paper, and that's usually 25.5 pound paper that's either tinted yellow or dyed yellow." Beaver dep. at 12. Petitioner currently publishes "approximately 260 separate directories, titles, with circulation of over 30 million." Walsh dep. at 15. These directories cover approximately 20 states, most of them east of the Mississippi River. Walsh dep. at 28. Petitioner uses the mark YELLOW BOOK to identify its directories. Beaver Exhibits 1-69. Petitioner's predecessor began publishing directories in New York State and in 1987, it expanded to Florida. Walsh dep. at 29, Beaver Exhibits 1-69. These directories are distributed free to the local community and every residence and business within the geographic area gets a copy of the directory. Beaver dep. at 11 and 45-46. Petitioner also publishes one business-to-business (B2B) directory for Kings, Queens, Nassau and Suffolk counties in New York. Beaver dep. at 32-33. Petitioner has no plans for any other B2B directories. Id. at 37.

Respondent currently publishes two directories entitled the Interstate Manufacturers and Industrial Directory Buyers Guide (Interstate Manufacturers) and the Midwest Manufacturers and Industrial Directory Buyers Guide (Midwest Manufacturers). Respondent has published only two directories annually for more than 60 years. Kass dep. at 45. Respondent has never used its mark on non-business telephone directories; its directories are designed "for business-to-business people," not ordinary consumers. Kass dep. at 45. Listings in respondent's directories include businesses in numerous states east of the Mississippi River including New York, New Jersey, Connecticut, and Pennsylvania. Kass dep. at 46. Respondent's directories are distributed to manufacturers, jobbers, wholesalers, buying offices, industrial plants, contractors, exporters, importers, factories, warehouses, engineers, architects, hotels, hospitals, public utilities, schools, chambers of commerce, and county, state and U.S. government purchasing departments. Kass dep. at 71-72 and Ex. 99 at 1. Respondent displays its YELLOW BOOK and shield design on the covers of these publications.

Petitioner argues that respondent's identification of goods is too broad and that there have been over sixty years of usage without any actual confusion because petitioner and respondent's goods as actually used are distinct.

Therefore, petitioner seeks to limit the identification of goods, which it believes will avoid even the theoretical likelihood of confusion. Respondent argues that its mark acquired secondary meaning first and that confusion remains likely. Respondent argues that its "identification of goods is very specific. Greater specificity isn't required."

Brief at 17.

The parties raise numerous issues in this proceeding, including whether the term "yellow pages" is generic for petitioner's goods (but not for respondent's goods), priority, likelihood of confusion, and various evidentiary objections. However, the key issue in this proceeding is whether petitioner's request to limit respondent's identification of goods should be granted.

Request to Limit Identification of Goods

Petitioner's primary request is to limit respondent's registration which, it submits, will eliminate even a theoretical likelihood of confusion. Petitioner maintains that it "strongly prefers the equitable outcome presented by Petitioner's proposed restriction" and it only requests to cancel respondent's registration in its entirety as an alternative if the Board rejects its preferred outcome. Petitioner's Br. at 1. Therefore, we address this issue first.

In order to prevail on a request to limit an identification of goods or services under Section 18 of the Trademark Act, a party must "plead and prove a ground for opposition or cancellation" and the proposed restrictions will be permitted "only if they [are] 'commercially significant.'" Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, 34 USPQ2d 1266, 1270 (TTAB 1995). In this case, petitioner has pleaded a ground of likelihood of confusion.³ When a party seeks to restrict the identification of goods under Section 18 (15 U.S.C. § 1068) alleging a likelihood of confusion, in order to be successful, it must "plead and prove, (1) that the entry of the proposed restriction will avoid a finding of likelihood of confusion, and (2) that the opponent is not using its mark on the goods or services that will be effectively excluded by the proposed restriction." Milliken & Co, v. Image Industries Inc., 39 USPQ2d 1192, 1194 (TTAB 1996). See also Dak Industries Inc. v. Daiichi Kosho Co., 35 USPQ2d 1434, 1437 (TTAB 1995). A restriction is "commercially significant" if it would avoid a finding of likelihood of confusion in the proceeding in which the restriction request has been made. Aries Systems Corp. v. World Book Inc., 26 USPQ2d 1926, 1930 (TTAB 1993). A request to amend an identification of goods or services

³ Respondent's mark is registered on the Supplemental Register. Marks on this register may be cancelled on this ground at any time. 15 U.S.C. § 1092.

under Section 18 is a request by the party, "in essence, for an equitable remedy." Milliken, 39 USPQ2d at 1196.

Therefore, we look to the registrant's use of the mark at the time restriction is sought rather than at the time it obtained the registration. Milliken, 39 USPQ2d at 1195-96.

In this case, respondent's goods in its registration are identified as "industrial directories, buyers guide and classified telephone directory published annually."

Petitioner is a publisher of yellow pages directories for various communities throughout the United States.

Petitioner's applications have been refused registration because of respondent's registration inasmuch as the "goods are related, classified telephone directories." Pet. Ex. 14 02278-2279. Indeed, petitioner's and respondent's goods are both identified in such a way that confusion between the marks YELLOW BOOK and YELLOW BOOK and design seems inevitable ("community classified telephone directories and business classified telephone directories" v. "industrial directory, buyers guide and classified telephone directory published annually").

Before the amendments to Section 18, the Board was constrained to decide cases presenting the issue of likelihood of confusion based upon the recitation of goods or services that appeared in a defendant's application or registration and a plaintiff's pleaded registration (assuming that common law rights were not asserted and proved by the plaintiff), rather than on the evidence adduced at trial as to the actual goods or services or the channels of trade of those goods or services. The amendments to Section 18 were intended

to give the Board greater ability to decide cases on the basis of the evidence of actual use.

Eurostar, 34 USPQ2d at 1268.

The facts of this case are appropriate for application of a restriction of the identification of goods under Section 18. Petitioner is seeking to restrict respondent's registration by identifying respondent's goods "with greater particularity, in terms of type, use, customers, trade channels, etc." Dak, 35 USPQ2d at 1437.

The parties for many years have contemporaneously used marks containing the words YELLOW PAGES in connection with buyers guides and classified telephone directors. Pages from the New York State Manufacturing & Industrial Classified Telephone Directory and Buyers Guide for the years 1938-39 contain a slightly different shield design with the words "The Yellow Book" in quotes. Kass Ex. 167. The 1950-51 edition of the Eastern Manufacturers and Industrial Directory appears to use the mark in the form that respondent eventually obtained as its registration.⁴ Kass Ex. 168. Also, Mr. Kass testified that, based on directories he saw when he first began to work for respondent's predecessor in 1955, respondent began using the

⁴ Since the exhibit is a black and white photocopy, it is not clear if the colors identified in the registration are actually used.

mark Yellow Book in 1936. Kass dep. at 153-54.⁵

Respondent's directories have consistently been designed "for business-to-business people," not consumers. Kass dep. at 45. The inside of its directories indicate that the directories are distributed to "top purchasing executives." Midwest Manufacturers, p. 1; Interstate Manufacturers, p. 1. Throughout its long existence, respondent has only published these two types of directories. Kass dep. at 45.

Petitioner, on the other hand, alleges that it first used the term YELLOW BOOK on the 1938 edition of Betty Gorinder's Yellow Book for Rockville Centre. The book is described on its cover as a "community telephone & business directory." Beaver Ex. 1. By the 1949 edition of the Rockville Center directory, the name "Betty Gorinder" was dropped. Petitioner distributes its directories to every residence and business in the area the directory serves. Beaver dep. at 45-46. Petitioner's directory is "a general population telephone directory" designed for the "residential consumer." Walsh dep. at 199; Beaver dep. at 172.

Interestingly, both petitioner and respondent have substantial operations in New York State and specifically the New York City area. Petitioner began its operations on Long Island and it continues to distribute its directories

⁵ Mr. Kass reported last seeing a copy of the 1936 directory

in Brooklyn, Queens, and Nassau and Suffolk counties of New York. Beaver dep. at 152. Respondent's offices are currently in New York City and it has been located there for years (Kass dep. at 22). Interstate Manufacturers lists businesses in, inter alia, New York (Kass dep. at 48). The Interstate Manufacturers directory (p. 1) indicates that it "contains free classified listings and paid advertisements of selected manufacturers and industrial concerns located in New York...." Respondent has also identified a 1938-39 directory called the New York State Manufacturers & Industrial Classified Telephone Directory and Buyers Guide as one of its former publications. Kass dep. at 116-119, Ex. 167. The directory uses a similar shield design and the words "The Yellow Book" in cursive. The exhibit identifies Rockville Centre as one of the towns and cities in which respondent distributed its directories. Kass Ex. 167, 0094. Petitioner has also published directories for Rockville Centre for years, beginning in 1938. Beaver Ex. 1; Exs. 2-64. Freeport is another city in which respondent's directories are distributed. It is also a city for which petitioner publishes its directories. Beaver Ex. 65. Petitioner describes its distribution as "a hundred percent saturation type distribution." Walsh dep. at 200.

about twenty-five years ago. Kass dep. at 8.

From the evidence of record, we draw the following conclusions. Petitioner's and respondent's directories are fundamentally different. Petitioner's directories are primarily consumer-oriented yellow pages directories that are distributed without charge to all customers within a geographic area. Respondent, on the other hand, publishes directories targeting professional purchasers, not the general public. Respondent does not and never has used its mark on community-oriented classified telephone directories distributed to all telephone subscribers. Its directories refer to "manufacturers and industrial" buyers. Both parties operate in the same geographic area, i.e., the New York City area. The parties have co-existed in this area for years. Neither party is aware of any actual confusion between the marks as currently used on the goods. Kass dep. at 111 and 115; Walsh dep. at 202-204.

While the absence of actual confusion is often not significant, it is one of the factors that we consider in likelihood of confusion cases and it does provide evidence that a narrowing in an identification of goods or services may be appropriate. G.H. Mumm & Cie v. Desnoes & Geddes Ltd., 917 F.2d 1292, 16 USPQ2d 1635, 1638 (Fed. Cir. 1990) ("Further, we note that despite over a decade of the marketing by Desnoes of Red Stripe beer in certain of the United States, Mumm was unable to offer any evidence of

actual confusion. This too weighs against a holding of a likelihood of confusion"). "We cannot think of more persuasive evidence that there is no likelihood of confusion between these marks than the fact that they have been simultaneously used for five years without causing any consumers to be confused as to who makes what." Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 50 USPQ2d 1545, 1555-56 (9th Cir. 1999); Oreck Corp. v. U.S. Floor Systems, Inc., 803 F.2d 166, 231 USPQ 634, 639 (5th Cir. 1986) ("Oreck's inability to point to a single incident of actual confusion [after seventeen months of concurrent use] is highly significant").

In this case, because of petitioner's "100% saturation distribution" in the same areas that respondent operates, it is reasonable to assume that there is an actual overlap in customers who would receive petitioner's consumer directory and respondent's manufacturer's and industrial buyers guide.⁶ This overlapping distribution has occurred for perhaps as long as sixty years and even respondent does not dispute that this has been the case since at least 1987.

⁶ We note that even petitioner's Business to Business Directory has been distributed in the New York City/Long Island area for more than ten years without any evidence of actual confusion. Beaver dep. at 7. Petitioner has indicated its intention to limit its goods and apparently its services to "community-oriented" directories "distributed free to all telephone subscribers." Brief at 23.

Therefore, because of the differences in the goods on which the marks are actually used, we are convinced that an amendment to the identification of goods is appropriate in this case. We find that petitioner has standing⁷ and that respondent has not been using its mark on community yellow pages. Furthermore, we find that restricting respondent's goods to manufacturing and industrial buyers guides is "commercially significant." Therefore, we grant petitioner's request to amend respondent's identification of goods under Section 18 to "manufacturing and industrial buyers guides published annually as classified telephone directories" and the petition to cancel the registration, in part, is granted.⁸

Genericness

We now discuss the remaining issues in this case. Respondent argues that "'Yellow Book' is generic when used to identify 'Yellow Pages.'" Brief at 18. Respondent argues that "[p]etitioner does not presently own a United

⁷ Petitioner's pending applications have been refused registration because they were held to be confusingly similar to respondent's registration.

⁸ Inasmuch as applicant's current identification of goods and services in its suspended applications (Serial Nos. 74/386,101 and 74/386,113) are also overly broad, petitioner has expressed its intention "to modify the description of goods in its applications to 'community-oriented 'yellow pages' classified telephone directories distributed free to all telephone subscribers located in the community served,' or 'classified 'yellow pages' telephone directories, featuring information and advertising about the goods and services of business and consumer entities organized by community or geographic groups of

States trademark registration for a mark which includes the term 'yellow book' and therefore respondent does not have an opportunity to assert a counterclaim to oppose or cancel the cited marks. Therefore respondent has raised the issue of invalidity of petitioner's mark by way of an affirmative defense." Brief at 18-19. Respondent also maintains that "[i]f yellow book is generic for petitioner's goods, respondent believes that petitioner should not be in a position to cancel, in whole or in part, respondent's trademark registration." Brief at 21.⁹ We do not find that petitioner's mark is generic and we discuss this issue for the sake of completeness inasmuch as this issue can be viewed as an attack on petitioner's standing.

The Court of Appeals for the Federal Circuit has held that: "The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." H. Marvin Ginn Corp. v. Int'l Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Ginn goes on to explain that:

communities,' or to such other language consistent with the Board's decision here." Brief at 23-24 (footnote omitted).

⁹ Respondent maintains that "counsel for petitioner and respondent stipulated that respondent's directories are not now and have not ever been a "yellow pages' classified telephone directory." Brief at 20.

Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

Id.

Respondent's evidence of genericness consists of statements that entities related to petitioner used in prior trademark applications.

[P]etitioner admitted that the "YELLOW BOOK" word combination ... forms only an insubstantial and descriptive portion of Applicant's Mark." In its response, petitioner admitted further that the words "Yellow Book," are descriptive, used much in the same manner as the term "Yellow Pages," to describe the goods as classified telephone directories.

Respondent's Brief at 20.

Respondent's evidence falls far short of establishing that petitioner's mark is generic. The "admission" clearly states that the term YELLOW BOOK is a "descriptive portion," that the words are "descriptive," and that they are made to "describe goods as classified telephone directories."

Inasmuch as petitioner's applications are claiming acquired distinctiveness under Section 2(f), it does not dispute that the mark YELLOW PAGES is descriptive. Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (An application under Section 2(f) is an admission that the mark is merely descriptive). It is a stretch to say that petitioner's equivocal statement that

its mark is "used much in the same manner as the term 'Yellow Pages' to describe the goods as classified telephone directories" is even referring to genericness since it specifically uses the term "describe." Certainly, it cannot be viewed as an admission that the mark is generic.¹⁰ Considering that there is little, if any, evidence of record that shows that petitioner's mark YELLOW BOOK is generic, we reject respondent's argument that the mark is generic.

Evidentiary Objections

With its brief, respondent attached Appendix A. This appendix consists of a ten-page chart, single-spaced, in 8 point type, containing respondent's objections to much of petitioner's evidence. While respondent has not bothered to number the objections, petitioner in its response includes a chart that indicates the number of objections is 157. We now address some of the major objections that respondent made to petitioner's evidence.

Petitioner submitted numerous exhibits with a statement entitled "Precertification by Maria Mitchell¹¹ of Domestic

¹⁰ Even if we were to determine that the statement was an admission that petitioner had at one time thought the term was generic, that would not control the outcome in this case. Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) ("The opinion of an interested party respecting the ultimate conclusion involved in a proceeding would normally appear of no moment in that proceeding").

¹¹ Petitioner also submitted precertification statements by Neal Baseline, Sylvia Chester, Terry Arciere and Paul Rouse to which respondent has made similar objections.

Records of Regularly Conducted Activity." See Fed. R. Evid. 902(11). Respondent objects to this statement.

[P]etitioner failed to provide prior written notice of intention to offer evidence per FRE 902(11); failure to obtain stipulation for testimony by affidavit; lack of foundation and failure to authenticate documents attached to precertification when placed into record of proceeding.

Respondent's Br. App. At A-1.

Petitioner responds by arguing:

Proper procedure under FRE 902(11) followed; proper foundation and authentication laid for exhibit as a business record by Mr. Rouse as well as by Mr. Walsh and Mr. Beaver as well; objection waived by Respondent's inaction.

Petitioner's Reply Brief at App. A-1.

Fed. R. Evid. 902(11) requires that a "party intending to offer a record into evidence under this paragraph" must provide written notice "sufficiently in advance of their offer into evidence to provide an adverse party with a fair opportunity to challenge them." The 2000 Advisory Notes indicate that the notice requirement is "intended to give the opponent of the evidence a full opportunity to test the adequacy of the foundation set forth in the declaration." Inasmuch as respondent had a full opportunity to test the adequacy of the declaration, we see no basis to exclude these statements. We also note that respondent has not raised any objections that would undermine the reliability of these documents. Indeed, the documents that we rely on

in this opinion were also authenticated by officers of petitioner's corporation.¹²

Respondent acknowledges that it has filed numerous objections to petitioner's notices of reliance for the first time with its brief. Objections to these documents on the grounds of lack of foundation and failure to authenticate are untimely. TBMP § 718.02(b) ("[A] procedural objection to a notice of reliance should be raised promptly, preferably by motion to strike").

Next, we address respondent's objection to the testimony of Mr. Beaver and Mr. Walsh to the extent that it objects to the testimony on the ground of hearsay because the witnesses were testifying about events that occurred prior to their employment with the petitioner. We are unaware of any exception to a hearsay rule that permits a corporation to have witnesses testify about the corporation's history when the witness has no personal knowledge of the events.

It will be observed that Rule 803(6), FRE, allows the admission into evidence of business records without the testimony of a witness with personal knowledge of the

¹² Respondent's objection that petitioner has failed to obtain a stipulation for testimony by affidavit is unclear. Certainly, Rule 902(11) permits, and indeed, requires a written declaration. We have only considered these somewhat verbose statements in regard to the admissibility of the documents and not as testimony directed to the merits of the case.

contents of the records, but the rule does not provide for the admission into evidence of the testimony of a person who lacks personal knowledge of the facts, who is unable to testify to the fulfillment of the conditions specified within the rule, and who is testifying only about what he has read or has been allowed to review.

Olin Corporation v. Hydrotreat, Inc., 210 USPQ 63, 67 (TTAB 1981). See also American Express Company v. Darcon Travel Corporation, 215 USPQ 529, 531 (TTAB 1982)

("Although he was the appropriate custodian of publication and distribution records relating to the "GOING PLACES" magazine, none of those was offered in evidence and his statements as to the extent of distribution of issues of "GOING PLACES" and the recipients thereof in 1975 must be regarded as hearsay testimony admissible under no relevant evidentiary exception").

Petitioner relies on the case of Transamerica Financial Corporation v. Trans-American Collections, Inc., 197 USPQ 43 (TTAB 1977) for the proposition that a witness is permitted to testify regarding corporate history "where corporate records ... on which his testimony is based, were admitted into evidence in the proceeding." Reply Brief at 26. Transamerica stated that "where a corporation has been in existence for a considerable period of time, there may not be an individual currently with the organization that could relate vital statistics of the business based upon personal knowledge and that therefore proper recourse may be made to

historical documents and similar documents maintained by the corporation, over the years, in the normal operation thereof or even to biographical matter providing the material is made of record subject to the scrutiny and cross-examination of the adverse party." 197 USPQ at 45 n.6. Therefore, we have considered the business records that petitioner has submitted and the testimony of its witnesses to the extent that they are testifying from personal knowledge.

We also note that there are a great number of other objections to testimony and exhibits, which were made during the course of the testimony period. Suffice it to say that we considered these objections and have accorded the evidence the appropriate weight.

Decision: The petition to cancel respondent's mark in part is granted to the extent that the registered mark's identification of goods is limited to "manufacturing and industrial buyers guides published annually as classified telephone directories."